UNITED STATES PATENT AND TRADEMARK OFFICE

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/837,627	04/19/2001	Jesse Perla	1351829.0015	8081

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EXAMINER
STEVENS, ROBERT

ART UNIT	PAPER NUMBER
2176	

DATE MAILED: 02/24/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

PTO-90C (Rev. 10/03)

	Application No.	Applicant(s)
Office Action Summary	09/837,627	PERLA ET AL.
	Examiner	**Art Unit**	
	Robert M Stevens	2176	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE _3_ MONTH(S) FROM
THE MAILING DATE OF THIS COMMUNICATION.
- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed
  after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
  Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any
  earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on _28 September 2004_.

2a)☒ This action is **FINAL.** 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is
closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) _1_ is/are pending in the application.

    4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) _1_ is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☒ The specification is objected to by the Examiner.

10)☒ The drawing(s) filed on _28 September 2004_ is/are: a)☒ accepted or b)☐ objected to by the Examiner.

    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

    Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

    a)☐ All b)☐ Some * c)☐ None of:

      1.☐ Certified copies of the priority documents have been received.

      2.☐ Certified copies of the priority documents have been received in Application No. _____.

      3.☐ Copies of the certified copies of the priority documents have been received in this National Stage
        application from the International Bureau (PCT Rule 17.2(a)).

    * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1)☐ Notice of References Cited (PTO-892)

2)☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

3)☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
    Paper No(s)/Mail Date _____.

4)☐ Interview Summary (PTO-413)
    Paper No(s)/Mail Date. _____ .

5)☐ Notice of Informal Patent Application (PTO-152)

6)☐ Other: _____ .

DETAILED ACTION

1.   This action is responsive to communications: **Application No. 09/837,627** amendment

filed 9/28/2004 to the original application filed 4/19/2001 by Perla et al. entitled "Method and

System for Building Internet-Based Applications". This application claims benefit of

continuation of Canadian PCT application no. PCT/CA01/00148 filed on 1/31/2001 and

continuation-in-part of US patent application no. 09/471,135 filed on Dec. 23, 1999.

2.   The Office withdraws the objections to the specification and drawings raised in the First

Action On the Merits (FAOM), as a result of the amended specification, **with the exception of**

issues concerning the first specification amendment appearing on p. 2 of the Amendment

(the replacement paragraph for the specification p. 2 lines 6-26). First of all, this paragraph is

riddled with poor grammar and run-on sentences. Secondly, Applicant still tries to improperly

incorporate by reference an apparently proprietary document (by Unwired Planet, Inc.) to which

neither the public nor the Office has access. The Office maintains the objections to specification

grammar/etc. problems and the attempt to improperly incorporate by reference which were

previously raised in the FAOM.

3.   **The Office maintains the FAOM rejection of claim 1 under 35 USC 112 first**

paragraph, after consideration of Applicant's Amendment. For further discussion, see

"Response to Arguments" section below.

4.   **The Office withdraws the FAOM rejection of claim 1 under 35 USC 112 second**

paragraph, after consideration of Applicant's Amendment.

5.   **The Office maintains the FAOM rejection of claim 1 under 35 USC 103(a)**, after

consideration of Applicant's Amendment. For further discussion, see "Response to Arguments"

section below.

6.   Claim 1 is pending. Claim 1 is independent.

Claim Rejections - 35 USC § 112

7.   The following is a quotation of the first paragraph of 35 U.S.C. 112:

> The specification shall contain a written description of the invention, and of the manner and process of making
> and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it
> pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode
> contemplated by the inventor of carrying out his invention.

8.   **Claim 1 is rejected under 35 U.S.C. 112, first paragraph**, as failing to comply with the

enablement requirement. The claim(s) contains subject matter which was not described in the

specification in such a way as to enable one skilled in the art to which it pertains, or with which

it is most nearly connected, to make and/or use the invention.

         Regarding claim 1, step "c" (recursively traversing ... or toolbars) was not described in

the specification in such a way as to enable one skilled in the art to which it pertains, or with

which it is most nearly connected, to make and/or use the invention. For purposes of

examination, the Office considers this limitation to encompass "recursively traversing schema

information".

Claim Rejections - 35 USC § 103

9.   The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all

obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in
> section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are
> such that the subject matter as a whole would have been obvious at the time the invention was made to a person
> having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the
> manner in which the invention was made.

10.   **Claim 1 is rejected under 35 U.S.C. 103(a)** as being unpatentable over Lau (US Patent

No. 6,598,219, foreign filed on Nov. 30, 1998) in view of North et al., Sam's Teach Yourself

XML in 21 Days, Sam's Publishing, March 1999, pages 459-465 and 471-480 (hereafter

"North"), and further in view of Loeb et al. (US Patent Application publication No.

2004/0078273, filed Dec. 8, 1999, hereafter referred to as "Loeb").

        Regarding independent (method) claim 1, Lau discloses:

        (currently amended) A method for building a web-based application comprising:

        (a) displaying a top level menu of types; (Fig. 1, pane #21 shows a top level menu of
types, with folder icons #120 and 140 selected/expanded to show further levels)

        (b) showing a schema within each level of the top level menu of types; (Fig. 1 folder icons
#150 and 160 reference icon folders for schemas)

        Lau further discloses a portion of step (c):

        to build cascading menus or toolbars; (Fig. 1, pane #21 shows a cascading menu of
types, with folder icons #120 and 140 selected/expanded to show further detail)

        However, Lau does not explicitly disclose the rest of step (c):

(c) recursively traversing the schema information

North, though, discloses this limitation on p. 465, especially noting the first sentence

under the heading "The Default Template Rule", teaching that the XSL processor recursively

processes the XML document tree to product an output tree).

It would have been obvious to one of ordinary skill in the art at the time of the invention

to apply the teachings of North for the benefit of Lau because to do so allowed a programmer to

process all the children of a matched source element as taught by as taught by North (see p. 471,

the last sentence under the heading "Processing", continuing through the first sentence under the

heading "Direct Processing").

Lau does not explicitly disclose:

(d) showing for each element of the menus or toolbars, all attributes; and

Loeb, however, discloses this limitation in Fig. 3A and 3B, showing an exemplary

schema with elements/attributes, Fig. 4 showing populated attributes of Fig. 3A/3B, and the Fig.

7 GUI form establishing a visual nexus between all the attributes listed in Fig 3A/3B and 4 and

the fields in Fig. 7.

It would have been obvious to one of ordinary skill in the art at the time of the invention

to apply the teachings of Loeb for the benefit of Lau in view of North because to do so would

ensure a high degree of security without unduly burdening a secondary merchant (recipient of the

populated schema) as taught by Loeb at col 6 para 0095.

Lau does not explicitly disclose:

(e) building a fully qualified path or relative path based on XSL patterns when a programmer selects a level.

North, however discloses this limitation on pp. 472-473 in code listing 20.11, especially lines numbered 30-37 in which the programmer uses a "for-each" construct to selectively build/traverse a relative path "CDs/CD" based upon XSL parameters.

It would have been obvious to one of ordinary skill in the art at the time of the invention to apply the teachings of North for the benefit of Lau and Loeb because to do so would allow a programmer to recursively process an XML file using a for-each construct as taught by North in the code listing on pp. 472-473, see especially the title of the listing.

It would have been obvious to one of ordinary skill in the art at the time of the invention to apply the teachings of Loeb for the benefit of Lau in view of North because to do so would ensure a high degree of security without unduly burdening a secondary merchant (recipient of the populated schema) as taught by Loeb at col 6 para 0095.

Note that the Office has made minor changes to the original FAOM 35 USC 103(a) rejection to reflect the proper figure reference (1 not 2) for the Lau reference, and remove repeated information concerning the North reference.

Response to Arguments

11.   **Applicant's arguments filed 9/28/2004 have been fully considered but they are not**

persuasive.

Applicant's remarks on pages 2-10 of the amendment concerning the drawings and

specification issues raised in the FAOM have been addressed in paragraph "2", above.

Applicant's remarks on page 10 of the amendment concerning the 35 USC 2nd paragraph

issues raised in the FAOM have been addressed in paragraph "2", above.

The Office maintains the FAOM 35 USC 112 1st paragraph rejection, in spite of

Applicant's arguments presented on p. 10 of the Amendment. Applicant's response to the raised

rejection is inadequate. Applicant's reference to the specification on page 27 lines 13-17 is

merely a reiteration of the claim language. Lines 17-18 only add that data definition types may

be on of those well known in the art. Applicant further adds that enablement lies buried

somewhere within the Figs. 9-12 and the associated description on pp. 19-27, and leaves it up to

the Office to "find enablement". Since Applicant cannot exactly locate an enabling description

within the specification, the Office maintains the FAOM 35 USC 112 1st paragraph rejection.

The Office maintains the FAOM 35 USC 103(a) rejection, in spite of Applicant's

arguments presented on pp. 10-12 of the Amendment. Concerning the FAOM 35 USC 103(a)

rejection, on page 11 of the Amendment, Applicant attacks the Office's motivation for

combining Loeb with Lau in view of North, indicating that 1) no motivation exists within

Lau/North and 2) that the motivation suggested does not "reach the limitations required by claim

1". First of all, motivation to combine a reference with another does **not** require that a

suggestion to combine be present in **all** references, as Applicant seems to suggest. The Office

has set forth motivation to provide a security benefit, as suggested by Loeb. Secondly, there is

no requirement that motivation be found for constructing Applicant's asserted invention. A

motivation to combine references is all that is required.

Also concerning the FAOM 35 USC 103(a) rejection, on page 12 of the Amendment

Applicant argues that the cited section does not teach the claim limitation. The Office, however,

asserts that the "for each" construct is used to recursively build a relative path (based upon the

relative path "CDs/CD", i.e., an XSL pattern) to render the output indicating selected CDs as

shown in Fig. 20.7 on p. 473.

Conclusion

12.   The Office maintains the 35 USC 103(a) rejection raised in the FAOM. Accordingly,

THIS ACTION IS MADE FINAL. See MPEP § 706.07(a). Applicant is reminded of the

extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE

MONTHS from the mailing date of this action. In the event a first reply is filed within TWO

MONTHS of the mailing date of this final action and the advisory action is not mailed until after

the end of the THREE-MONTH shortened statutory period, then the shortened statutory period

will expire on the date the advisory action is mailed, and any extension fee pursuant to 37

CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event,

however, will the statutory period for reply expire later than SIX MONTHS from the date of this

final action.

13.   Any inquiry concerning this communication or earlier communications from the

examiner should be directed to Robert M Stevens whose telephone number is (571) 272-4102.

The examiner can normally be reached on M-F 6:00 - 2:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's

supervisor, Joseph H. Feild can be reached on (571) 272-4090. The current fax phone number

for the organization where this application or proceeding is assigned is 703-872-9306.

Additionally, the main number for Technology Center 2100 is (571) 272-2100.

Information regarding the status of an application may be obtained from the Patent

Application Information Retrieval (PAIR) system. Status information for published applications

may be obtained from either Private PAIR or Public PAIR. Status information for unpublished

applications is available through Private PAIR only. For more information about the PAIR

system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR

system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Robert M. Stevens
Art Unit 2176
Date: February 15, 2005

JOSEPH FEILD
SUPERVISORY PATENT EXAMINER

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